

REMARKS

This is responsive to the final office action on August 29, 2006. The Office Action rejected claims 1-8 and 22-56 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claims 1-2, 4, 5, 8, 22-23, 26 and 41-42 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Clarke (U.S. Publication No. 2006/0053043). Claims 3, 6-7, 9-12, 15, 20-21, 24, 27-28, 30-34, 37, 39-40, 43, 45-50, 53 and 55-56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clarke in view of Morgan et al. (U.S. Patent No. 5,799,286). The Examiner rejected claims 4, 8, 25, 29 and 44 under 35 U.S.C. §103(a) as being unpatentable over Clarke. Claims 13-14, 16-19, 35-36, 38, 51-52 and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Clarke and Morgan, and further in view of Thompson (U.S. Patent No. 7,020,619).

The claim rejections are respectfully traversed in view of the remarks presented herein. Favorable reconsideration is respectfully requested.

The Finality of the Office Action Is Premature and Improper

The Examiner made this Office Action final. It is respectfully submitted that the finality of the Office Action is premature and improper and should be withdrawn because the Examiner introduced a new ground of rejection that is neither necessitated by Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

In a previous Office Action issued on April 19, 2006, the Examiner rejected all the independent claims under 35 U.S.C. §102(e) as being **anticipated** by Clarke. In supporting the anticipation rejection, the Examiner cited various sections in Clarke that purportedly meet claimed limitations.

Responding to the anticipation rejection based on Clarke, Applicants filed a Response on August 2, 2006 pointing out that even though Clarke is a continuation-in-part of application No. 09/837,807 (hereinafter “the ‘807 application”), the specific descriptions and sections relied on by the Examiner were not part of the original disclosure of the ‘807 application. Since the specific sections relied on by the Examiner do not have proper support in the earlier application, **Clarke cannot enjoy the benefit of the filing date of the ‘807 application** with respect to the specific sections. See MPEP 706.02(f)(1). As Clarke’s filing date is later than that of the instant patent application, Applicant traversed the anticipation rejection, without amendment, by pointing out that Clarke is not an effective reference under §102(e)/103.

In this Office Action, the Examiner rejected the independent claims on a different ground as unpatentable over Clarke, but made the Office Action final. Since the Examiner introduced a new ground of rejection not necessitated by Applicants amendment or submission of prior art, the finality of the Office Action is premature and should be withdrawn. See MPEP 706.07(2a).

Clarke Is an Effective Reference Only to the Extent that the Earlier Application Has Proper Support

Contrary to the Examiner’s assertion that the entire document of Clarke enjoys priority from the ‘807 application, Applicants respectfully submits that Clarke can enjoy the priority date of the ‘807 application **only** to the extent that the ‘807 application provides proper support for the subject matter disclosed in Clarke. Clarke cannot enjoy priority from the ‘807 patent if the subject matter described in Clarke lacks support from the ‘807 application. See *Tronzo v. Biomet, Inc.*, 16 F.3d 1154.

The Obvious Rejections Based on Clarke Are Overcome

Claims 1-2, 4, 5, 8, 22-23, 26 and 41-42 were rejected as being unpatentable over Clarke. The obviousness rejection is respectfully overcome because Clarke cannot support a prima facie case of obviousness.

Independent claim 1 recites:

A capacity planning method comprising the machine-executed steps of:
receiving a plurality of tasks of a financial institution;
identifying a plurality of subtasks associated with each of the plurality of received tasks, wherein the identified subtasks are of different types and are needed to perform each respective task of the financial institution;
accessing production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks; and
calculating a work volume of the financial institution based on the identified subtasks and the production rate information.

The Examiner **acknowledged** that Clarke does **not** explicitly teach various claimed limitations relating to financial institutions such as “receiving a plurality of tasks of a financial institution; identifying a plurality of subtasks associated with each of the plurality of received tasks, wherein the identified subtasks are of different types and are needed to perform each respective task of the financial institution; ...and calculating a work volume of the financial institution based on the identified subtasks and the production rate information.” However, despite these deficiencies of Clarke, the Examiner contended that the Background section of this application includes well-known information that would provide guidance to modify Clarke to meet the claim limitations. Applicants respectfully disagree.

As the name “BACKGROUND OF THE DISCLOSURE” suggests, discussions in that section are intended as background information about the invention only and do **not** constitute any admissions of prior art. Otherwise, the section would have been titled “Discussion of Know Art” or “Discussion of Prior Art.”

In this application, the Background section provides descriptions of the inventors' ingenious insights and observations that could not be found in prior art. The specific paragraphs cited by the Examiner read as: "In an organization, such as a bank, clearing house, clearing center, or an insurance company, where numerous complex tasks are performed by its employees, it is important to know whether the capacity of the organization is sufficient to handle the number of incoming tasks. If not, additional resources need to be located/assigned, such as bringing in part-time or temporary workers, extending work hours, borrowing staff from other departments, etc., in order to perform the tasks as required in the appropriate timeframe." This paragraph describes the inventors' ingenious insights and observations of problems encountered and shared by many financial institutions and is not an admission that the descriptions in the Background section falls in prior art. The Examiner's assertion that the discussion in this section constitutes prior art and the reliance thereon are misplaced.

Additionally, contrary to the Examiner's contention that the claims' recitations of "financial institution" are mere intended use, the term "financial institution" in fact is extensively used throughout the body of the claims and breathes life and meaning into the claims and should be accorded patentable weight. For instance, claim 1 specifically describes a capacity planning method that receives a plurality of tasks of a financial institution, identifies a plurality of subtasks associated with each of the plurality of received tasks of the financial institution, accesses production rate information related to the amount of time or the number of staff needed to perform each of the identified subtasks associated with the tasks of the financial institution, and calculates a work volume of the financial institution. As the claim specifically requires processing data related tasks and production rate information of a financial institution, and generating results that identify subtasks of the tasks of the financial institution and a work

volume of the financial institution, the claim depends on the specific recitation of “financial institution” for completeness. Accordingly, the term “financial institution” is limiting.

Furthermore, a *prima facie* case of obviousness under 35 U.S.C. § 103 requires three criteria be met. First, the references, when combined, must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation of success for the modification or combination of references. The teaching or suggestion to make the modification or combination of prior art and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As already acknowledged by the Examiner, Clarke fails to disclose every limitation of claim 1. Moreover, as discussed earlier, the Office Action erred by relying on Applicants' own disclosure in rejecting the claims. Therefore, Clarke cannot support a *prima facie* case of obviousness. Accordingly, the obviousness rejection is untenable and should be withdrawn.

Claims 22 and 41 include descriptions substantially similar to those of claim 1. Therefore, claims 22 and 41 also are patentable over Clarke for at least the same reasons as for claim 1.

Claims 2, 4, 5, 8, 23, 25, 26, 29, 42 and 44, directly or indirectly, depend on claims 1, 22 and 41, respectively. Therefore, claims 2, 4, 5, 8, 23, 25, 26, 29, 42 and 44 are patentable over Clarke at least by virtue of their dependencies.

Claims 3, 6-7, 9-12, 15, 20-21, 24, 27-28, 30-34, 37, 39-40, 43, 45-50, 53 and 55-56 were rejected as being unpatentable over Clarke in view of Morgan, and claims 13-14, 16-19, 35-36,

38, 51-52 and 54 were rejected as being unpatentable over Clarke and Morgan, and further in view of Thompson.

Morgan was cited by the Office Action for its purported discussion of calculating work volume as the number of time units needed to perform the identified subtasks, providing a capacity report and different types of information of employees; and Thompson was cited for its alleged disclosure of comparing work volume with available employees and calculating work time. However, neither Morgan nor Thompson specifically disclose or suggest modifying Clarke in a specific manner to meet every limitation of the claims. Therefore, Clarke, even if combined with Morgan and Thompson, does not disclose every feature of claims 3, 6-7, 9-21, 24, 27-28, 30-40, 43 and 45-56. The obviousness rejections of claims 3, 6-7, 9-21, 24, 27-28, 30-40, 43 and 45-56 are overcome.

The Rejection Under 35 U.S.C. 112, First Paragraph Is Overcome

The Office Action rejected claims 1-8 and 22-56 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **enablement** requirement. Specifically, the Office Action asserted that the phrase “financial institution” was not disclosed in the specification.

However, 35 U.S.C. 112, first paragraph only requires the claimed subject matter be described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Even though the specification does not use the literally identical phrase “financial institution,” the specification pointed out problems shared by “a bank, clearing house, clearing center, or an insurance company”, which are all financial institutions. See paragraph [0003] of the written description. The Detailed Description of Illustrative Embodiments section also provides detailed descriptions on embodiments using a clearing house, which is a financial institution, as an illustrative

example to show the operations of the exemplary capacity planning system. Based on the disclosure of this application, people skilled in the art would understand how to make and/or use the invention related to any financial institutions by referring to the descriptions and examples provided in the disclosure. Since people skilled in the art are enabled to carry out the claimed invention by reviewing the application, the application fully meets the requirements under 35 U.S.C. 112, first paragraph. The rejection under 35 U.S.C. 112, first paragraph is overcome.

Incidentally, Applicants note that the Office Action's assertion that the application's Background section provides teaching related to "a financial institution" echoes Applicants' position that the application provides sufficient support for the claimed limitation "financial institution" and contradicts the Office Action's own arguments related to the rejection under 35 U.S.C. 112, first paragraph.

Conclusion

Applicants believe that this application is in condition for allowance, and request that the Examiner give the application favorable reconsideration and permit it to issue as a patent. If the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representatives listed below.

Application No.: 10/725,205

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink that reads "Wei-Chen Chen". The signature is fluid and cursive, with the first name "Wei-Chen" and the last name "Chen" clearly distinguishable.

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